

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX CORP.
Petitioner

v.

ALCON RESEARCH, LTD
Patent Owner.

Cases IPR2013-00428 (Patent 8,268,299 B2)
IPR2013-00429 (Patent 8,323,630 B2)
IPR2013-00430 (Patent 8,388,941 B2)¹

Before LORA M. GREEN, FRANCISCO C. PRATS, and RAMA G. ELLURU,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

DECISION

Apotex Corp.'s Motion for *Pro Hac Vice* Admission of
Paul A. Ainsworth
37 C.F.R. § 42.10

¹ This order addresses issues that are the same in all three cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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Petitioner, Apotex Corp., (“Apotex”), filed a Motion for *Pro Hac Vice* Admission of Paul A. Ainsworth Under 37 C.F.R. § 42.10(c) (Papers 16, 14, and 15),² accompanied by an Affidavit of Mr. Ainsworth in support of the Motion (Ex. 1017 in each proceeding). At the initial conference held on February 3, 2014, Patent Owner indicated that it had no objection to the Motion. For the reasons provided below, Apotex’s Motion is *granted*.

As set forth in 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner. For example, where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c). In authorizing motions for *pro hac vice* admission, the Board also requires a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding. See Paper 4 in each proceeding (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” Paper 6 in IPR2013-00010).

In its Motion, Apotex asserts that there is good cause for Mr. Ainsworth’s *pro hac vice* admission because: (1) Mr. Ainsworth is an experienced patent litigation attorney, and (2) Mr. Ainsworth has an established familiarity with the subject matter at issue in the instant proceedings as he has engaged in hours of

² All references to the papers refer to the three proceedings in numerical order; *i.e.*, the first paper number refers to the paper number in IPR2013-00428, the second paper number refers to the paper number in IPR2013-00429, and the third paper number refers to the paper number in IPR2013-00430.

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strategic and substantive discussions regarding the proceedings with lead counsel for Petitioner in the proceedings, is familiar with ophthalmic compositions such as those covered in the '299, '630 and '941 patents through previous litigation involving similar ophthalmic compositions, and has served as trial counsel for Petitioner in district court litigation concerning patents directed to ophthalmic drug formulations and methods of use. (Papers 16, 14, and 15 at 5-7). In support of the Motion, Mr. Ainsworth attests to these facts in his Affidavit with sufficient explanations. Ex. 1017. Moreover, Apotex's lead counsel, Eldora L. Ellison, is a registered practitioner. (Papers 16, 14, and 15 at 3).

Based on the facts set forth above, we conclude that Mr. Ainsworth has sufficient legal and technical qualifications to represent Apotex in this proceeding and that there is a need for Apotex to have its trial counsel involved in these proceedings. *See* IPR2013-00639, Paper 7, dated October 15, 2013 (superseding IPR2013-00010, Paper 6, dated October 15, 2012, and setting forth the requirements for *pro hac vice* admission) (copy available on the Board Web site under "Representative Orders, Decisions, and Notices"). Accordingly, Apotex has established good cause for Mr. Ainsworth's *pro hac vice* admission. Mr. Ainsworth will be permitted to appear *pro hac vice* in the instant proceeding as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

For the foregoing reasons, it is

ORDERED that Apotex's Motion for *Pro Hac Vice* Admission of Mr. Ainsworth for the instant proceeding is granted; Mr. Ainsworth is authorized to represent Apotex as back-up counsel in the instant proceedings;

FURTHER ORDERED that Apotex is to continue to have a registered practitioner as lead counsel in the instant proceedings;

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FURTHER ORDRED that Mr. Ainsworth is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Title 37, Part 42 of the Code of Federal Regulations; and

FURTHER ORDERED that Mr. Ainsworth is to be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.*

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